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BOARD OF PATENT APPEALS AND INTERFERENCES

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BOARD OF PATENT
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MAR 16 2004

Appellant: David F. Gavin
Craig Waldron
Robert J. Martin
George A. Polson

Appeal No.: 2001-1647

Serial No.: 09/120,664

Examiner: B. Celsa

Filed: July 22, 1998

Art Unit: 1627

Assignee: Arch Chemicals, Inc.

For: COMPOSITE BIOCIDAL PARTICLES

Certificate of Mailing	
Date of Deposit	<u>February 15, 2002</u>
I hereby certify under 37 CFR 1.8(a) that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated above and is addressed to Commissioner for Patents, Washington, DC 20231.	
Signed:	<i>[Signature]</i>
Name:	<u>DALE LYNN CARLSON</u>

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Commissioner for Patents
U.S. Patent and Trademark Office
Washington, D.C. 20231

REQUEST FOR REHEARING OF AN ADVERSE DECISION OF THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Dear Sir:

This Request for Rehearing is in response to the Decision of the Board Of Patent Appeals and Interferences mailed on December 17, 2001 in the above-identified application.

No fee is believed to be required for submission of this Request for Rehearing. However, if any fee is due or any additional charges associated with this submission, kindly charge Deposit Account No. 23-1665. This Request for Rehearing is submitted in triplicate.

REMARKS

In its decision mailed on December 17, 2001, the Board of Patent Appeals and Interferences upheld the final rejection of instant claims 1, 38, 40 and 41, being all claims presently on appeal, as allegedly "clearly anticipated" under 35 U.S.C. 102(e) over the Morris patent (i.e., U.S. Patent 5,916,947). Support for the Board's upholding this rejection is found *inter alia* in the sentence bridging pages 13 and 14 of the Board's Opinion wherein it is stated that "The Morris "core" and "shell" appear to be made from the same "core" and "shell" materials mentioned in the claims on appeal. However, it is respectfully asserted that the Morris patent nowhere discloses or suggests any methodology for preparing a shell or a core of any kind, much less as instantly claimed.

As support for the Board's position in affirming the Examiner's rejection based upon the Morris patent, the Board refers to column 6, lines 24-25 of Morris, wherein it is stated that "according to Morris, surface coating the zinc oxide with zinc pyrithione 'helps ensure that the *** [zinc pyrithione] contacts the zinc oxide'". However, contact of zinc oxide with zinc pyrithione is respectfully believed to be irrelevant to the instantly claimed invention. Illustratively, instant claims 1 and 40 require that the shell comprise a pyrithione adduct comprising "a REACTION PRODUCT [emphasis inserted] of pyrithione with a portion of said core metal or metal compound". This claim phraseology was apparently construed by the Board at page 14 of the Board's Opinion as "a process limitation". However, appellants respectfully assert that this claim language is instead a product limitation requiring that the shell comprise the recited reaction product. Instant claim 38 also contains a product limitation with respect to the shell, inasmuch as that claim requires that the shell comprise "a pyrithione adduct derived from a portion of the core metal".

Assuming arguendo that Morris discloses a core and a shell (which it does not), the

teaching at column 6, lines 24-25 of Morris that the photosensitizer (e.g., zinc pyrithione) CONTACTS [emphasis inserted] the zinc oxide cannot provide the instantly claimed reaction product or shell's pyrithione adduct derived from a portion of the core metal" as instantly claimed. The reason is that it is impossible for Morris' zinc pyrithione to react with the zinc oxide is because each of these two compounds contain the same metal, namely zinc. There is no "driving force" to cause the zinc to chelate since the metal (zinc) is identical in both compounds. Contrarywise, the "transchelation" described in the paragraph bridging pages 12 and 13 of the instant specification employs CUPROUS oxide and SODIUM pyrithione (i.e., two different cations, copper and sodium), thus enabling the sodium pyrithione to react with the cuprous oxide to form copper pyrithione, as described in the instant specification. Thus, although the contact of zinc oxide with zinc pyrithione can provide a physical combination, it cannot provide the reaction product of pyrithione with core metal as instantly claimed

Accordingly, reconsideration of the Board's affirming the Examiner's rejection of the instant claims on appeal over the Morris patent is respectfully requested and earnestly solicited.

Respectfully submitted,

FEB 15, 2002
Date

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